



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/753,450

01/09/2004

Kiyoshi Tateishi

041465-5216

8423

55694 7590 08/22/2007
DRINKER BIDDLE & REATH (DC)
1500 K STREET, N.W.
SUITE 1100
WASHINGTON, DC 20005-1209

EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT

PAPER NUMBER

2627

MAIL DATE

DELIVERY MODE

08/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/753,450	Applicant(s) TATEISHI ET AL.	
	Examiner Aristotelis M. Psitos	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 3-9, 11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10, 12, 14-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 2627

DETAILED ACTION

Applicants' response of 6/28/07 has been considered with the following results.

Applicant's election of Group I (claims 1,2,10,12,14-17) in the reply filed on 6/28/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 3-9, 11 and 13 are withdrawn from consideration.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The submitted IDS es have been received and made of record.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations of claims 15-16 and 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Art Unit: 2627

Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, although the disclosure alludes to permitting the system "on its own" to determine the predetermined time period, how/what/where etc this is accomplished is not found to any degree of specificity for one of ordinary skill in the art to make and use the invention.

No art can be developed against this claim, since there is insufficient disclosure as to what it is that applicants' have invented.

As far as the claims recite positive limitations, the following art rejections are made.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Art Unit: 2627

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1,2,10,12 and 14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10/4 and 16/14 (with respect to the product claim 12) of U.S. Patent No. 7109462 in view of Maeda et al & Abe et al.

The divergence of the claimed subject matter is not patentable distinct, since as claimed herein the invention is drawn to a combination of rec/repr and erasing functions (as defined) between multi-pulse and single pulse(s). The previous patent, especially claim 10/4 provides for the ability of the multi-pulse and single pulse recording. The claims fail to depict any erasing capability.

The Maeda et al and Abe et al prior art systems are drawn to erasing as well as recording capabilities, wherein multiple erasing pulses are provided for - in Maeda et al - see his discussion with respect to figure starting at col.2 line 25 and continuing till at least col. 34 line 20, as an improvement over a single pulse erasing ability.

Abe et al depicts a single pulse erasing capability - see the depiction/explanation with respect to figures 3 and 16 (erase pulse) of various time lengths.

The present claimed invention would have been an obvious modification using the above additional teachings from both Maeda et al and Abe et al to also use a switching ability between multiple and single erase pulse(s) for the reasons identified/discussed in the above secondary systems.

Method claim 10 is met, i.e., obvious equivalent to the above apparatus claims.

The limitations of claim 14 are present/ different levels between the multi-pulse writing and multi-pulse erasing beams - by definition such difference levels must exist, else one is neither writing nor erasing.

3. Claims 15 and 16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10/4 of U.S. Patent No. 7109462 in view of Maeda et al & Abe et al as relied upon above in paragraph 2 and further considered with:

Art Unit: 2627

a) themselves with respect to claim 15 – i.e., the apc is considered the predetermined time period of the above parent patent claim;

b) alternatively claim 15 is further obvious in view of Masui et al, the use of apc timing for generating the sampling periods/ i.e., the predetermined time periods and

c) with respect to claim 16, as obvious further considered with Yamanoi et al, with respect to the teaching of the capa or llp addressing capabilities and use thereof for sampling.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2627

4. Claims 1,2 10,12 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoi further considered with Maeda et al & Abe et al.

Yokoi discusses – as is recognized in the submitted IDS with respect to the previous search report – (see the discussion with respect to EP 1207525) –i.e., the US equivalent document thereof – a multi-pulse and single pulse capability with the appropriate timing and switching there between. There is no clear depiction that such can also be used for the erasing capability, however, as discussed above in paragraph 2 with respect to the secondary references, such is so taught/recognized by these systems.

It would have been obvious to modify the base system of Yokoi with the above additional teachings from both Maeda et al and Abe et al, motivation is to provide for an analogous switching between multi-pulses and single pulse for erasing as well as writing capabilities for the discussed advantages in the secondary systems.

The product limitations of claim 12 are present when providing such a product for a computer environment/system.

The limitations of claim 14 are self evident and present in the above references, i.e., different levels for the writing and erasing pulse(s).

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1,2,10,12, and above, and further in view of Masui et al.

With respect to the capability of having the apc as providing a basis for the predetermined time period as the sampling signal of the emitting device, such is further taught by the Masui et al system.

Use of the apc timing as the timing in the above system is considered an obvious modification, i.e., selection of appropriately provided regions for sampling signals is well known and the correlation between the apc period as such is merely a selection between equivalent sources for sampling, in the disc arts.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1,2,10,12, and above, and further in view of Yamanoi et al.

Art Unit: 2627

Various recognized address signal formats are known as further established/taught by the Yamanoi et al system.

The ability to select such to serve as a basis/ for or as the sampling signals to yield the appropriate timing relationship necessary in order to control the emitting device is considered a selection between alternative equivalent(s) in the disc arts.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shigemori – see the erase pulse described in figure 3.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-F: 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos
Primary Examiner
Art Unit 2627



AMP